

While Boon et al. discloses a MAGE protein that is recognized by T cells and can bind to MHC class I antigens, Boon et al. fails to disclose a protein, that through intracellular degradation, results in peptide fragments that bind to MHC claim I antigens, as well as be recognized by T cells in the binding state. Thus, Boon et al. fails to disclose all of the claimed limitations of the instant claim 1. Accordingly, Boon et al. does not destroy the special technical feature linking the claims under PCT Rule 13.1.

Accordingly, the subject matter of Groups I through III are linked as forming a single general inventive concept under PCT Rule 13.1 because they possess the same or corresponding special technical features. The special technical feature of this invention is tumor antigen proteins, which is represented by the claims of Group II. The genes of Group I encode the proteins of Group II. As such, at least the claims of Groups I-II should be rejoined.

Applicants draw the Examiner's attention to Annex B (PCT Administrative Instructions) of the MPEP wherein example 17 of page AI-43 clearly states that a protein and the DNA encoding said protein are linked by a unity of invention.

"Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 [Protein X] and 2 [DNA sequence encoding protein X] is accepted."

As such, the Examiner is required to examine a protein and the DNA sequence encoding said protein together. Therefore, Groups II and I must be rejoined.

Furthermore, Applicants respectfully submit that the Examiner has not established that there is an *undue* burden in searching for all claims as required by MPEP § 803. The Examiner does not state how many classes or subclasses must be searched to properly examine the application. Therefore, the Applicants can only assume that an undue burden for searching does not exist.

For all of the above reasons, Applicants respectfully request that the restriction requirement be withdrawn, and Groups I through III be recombined. An early and favorable action on the merits of the present application is earnestly solicited.

If the Examiner has any questions concerning this application, the Examiner is requested to contact the Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at (703) 205-8000.

Application No. 09/202,047

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 


Gerald M. Murphy, Jr.

Reg. No. 28,977

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000


GMM/KLR
Attachment

PCT ADMINISTRATIVE INSTRUCTIONS

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

Example 15

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

Example 16

Claim 1: An insecticide composition comprising compound A (consisting of $a_1, a_2 \dots$) and a carrier.

Claim 2: Compound a_1 .

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance. There is nevertheless still unity between the subject matter of claims 1 and 2 provided a_1 has the insecticidal activity which is also the special technical feature for compound A in claim 1.

Example 17

Claim 1: Protein X

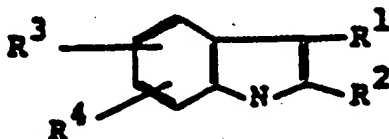
Claim 2: DNA sequence encoding protein X.

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

III. MARKUSH PRACTICE

Example 18 — common structure:

Claim 1: A compound of the formula:



wherein R^1 is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; R^2 – R^4 are methyl, benzyl, or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.